UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte SHIGEO OZAWA

Appeal No. 2005-1700
Application No. 09/519,999

HEARD: September 14, 2005

Before KIMLIN, KRATZ and JEFFREY T. SMITH, Administrative Patent Judges.

JEFFREY T. SMITH, Administrative Patent Judge.

REMAND TO THE EXAMINER

Appellant appeals the Examiner's final rejection of claims 10, 11, 13 to 18, 20 to 25, 27 and 29 to 33, which are all of the claims pending in this application. Because the issues are not ripe for appeal, we remand.

OPINION

The Examiner relied on an English language translation of Japanese patent 06-329179 issued to Yoshio on November 29, 1994 as evidence of obviousness. A close inspection of this translation reveals that the document states "Japan Patent Office is not responsible for any damages caused by use of this translation. 1. This document has been translated by computer. So the translation may not reflect the original precisely." This document is not suitable for the proper determination of patentable subject matter by the Board of Patent Appeals and Interferences.

The Examiner needs to obtain a certified translation that adequately reflects the original patent precisely. Upon receipt of the translation, the Examiner should reevaluate the relevance of the newly obtained English language translation.

The Board of Patent Appeals and Interferences is a board of review and not a vehicle for initial examination. See 35 U.S.C. § 6(b)(2000). The burden is on the Examiner to set forth a *prima facie* case of obviousness. *See In re Alton,* 76 F.3d 1168, 1175, 37 USPQ2d 1578, 1583 (Fed. Cir. 1996). Findings of fact and conclusions of law must be made in accordance with the Administrative Procedure Act, 5 U.S.C. 706 (A), (E) (1994). *See Zurko v. Dickinson,* 527 U.S. 150, 158, 119 S.Ct. 1816, 1821, 50 USPQ2d 1930, 1934 (1999). Findings of fact relied upon in making the obviousness rejection must be supported by substantial evidence within the record. *See In re Gartside*, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1775 (Fed. Cir. 2000).

In light of the above facts, we feel it is premature to decide this appeal. More fact finding needs to be completed on the record by the Examiner in view of a certified full translation of the Japanese Patent.

CONCLUSION

In summary, the instant application is remanded to the Examiner to consider the aforementioned issues and to act accordingly.

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further consideration of a rejection. Accordingly, 37 CFR 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

TIME FOR TAKING ACTION

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv)(effective Sep. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sep. 7, 2004)).

REMAND

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Administrative Patent Judge)
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